

**UNITED STATES DEPARTMENT OF COMMERCE****Unit d States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/836,870 04/17/01 JENSEN

C 10209.166

EXAMINER

HM12/1108

KIRTON & MCCONKIE
1800 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY UT 84111

YU, G

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

11/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application N .

09/836,870

Applicant(s)

JENSEN ET AL.

Examiner

Gina C. Yu

Art Unit

1619

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☒ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☒ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as the scope of the claims is inconsistent with the disclosure in the specification. Claims 1-17 are directed to compositions containing *Morinda Citrifolia*. The specification, while enabling the use of the juice or oil extract of *Morinda Citrifolia* for the instant invention, does not reasonably provide support for using other parts of the plant. The remaining claims are rejected as depending on indefinite base claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-17 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention.

(A) Moniz (U.S. Pat. No. 5,288,491) teaches that most parts of *Morinda Citrifolia* have been used as ancient folk medicine in the Pacific. See col. 1, line 40 – col. 2, line 65. Examiner views that the instant claims, drawn to a composition containing *Morinda Citrifolia*, are by met the disclosure. Although the reference is silent as to the amount of the plant present in the usage,

Art Unit: 1619

examiner views that the juice diluted with water, the oil extract for hair application, or “mashed fruit” drink inherently meet the weight limitation of the instant claims, unless proven otherwise by the applicants.

2. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Kondo et al. (JP200095663A, machine translation) (“Kondo”).

Kondo teaches cosmetic composition comprising plant extracts which provide skin whitening, oxygen scavenging and/or antimicrobial effect. *Morinda Citrifolia* is among the plant extracts disclosed in the reference. See translation, paragraphs [0001- -0009]. Table 1 shows the formulation of the composition comprising 4.8 % of *Morinda Citrifolia*.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 3-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo in view of Duffy et al. (U.S. Pat. No. 5,472,699) ("Duffy").

Kondo, discussed above, further teaches the invention may be formulated into various types of cosmetic compositions, including skin care lotion and face toilet, which is considered as a skin toner product. See translation, paragraph [0017]. The whitening effect of Mulberry bark extract (which is deemed to be Indian Mulberry) is also discussed in paragraphs [0025-36] and Table 2. The reference further teaches that the cosmetic compositions may include the additives which meets instant claims 19-26. The reference lacks the teaching of the specific weight ranges of *Morinda Citrifolia* and the specific additives of instant claims. Examiner views that one of ordinary skill in the art would have discovered the optimum weight range of the component by routine experimentations.

Duffy teaches a cosmetic composition comprising botanical astringent comprising extracts from Witch Hazel, Linden which is a source of vitamin C, E, and farnesol, and St. John's Wort which is a source of vitamin A. Employing silica, water, ethyl alcohol (denatured alcohol), glycerin, pyridoxine HCL, fragrances, thickeners, preservatives, and colorants are also disclosed. The reference teaches that the invention helps reduce the size of pore of the skin and control sebum secretion.

Given the general teaching of making cosmetic compositions from *Morinda Citrifolia* in Kondo, one of ordinary skill in the art at the time the invention was made to have looked to prior arts such as Duffy for specific additive components suitable for botanical astringents and modified the composition of Kondo by incorporating such additives because of the expectation

Art Unit: 1619

of successfully producing a skin care composition that improves skin appearance by whitening the skin, reducing the pore size and controlling oil secretion, and/or provides antiseptic effect.


Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dittmar, A. (J. Herbs Spices Medicinal Plants, 1993, teaching external usage of Morinda Citrifolia leave extract for chest cold in Samoa.).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-305-3593. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
November 2, 2001


DIANA DUDASH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600